

### REMARKS

Claims 1, 3-9, 11-17, 19-25 and 27-32 remain in this application. Claims 1, 3, 9, 11, 17, 19, 25 and 27 were amended in this response. Claims 2, 10, 18 and 26 were canceled, without prejudice. No new matter has been introduced as a result of the amendments.

Claims 1, 4, 5, 8, 9, 12, 13, 16, 17, 20, 21 and 24 are rejected under 35 U.S.C. §102(e) as being anticipated by *Bradshaw* (US Patent 6,674,731).

Claims 2, 3, 10, 11, 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bradshaw* (US Patent 6,674,731) in view of *Gernert* (US Patent 6,600,734).

Claims 6, 14 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bradshaw* (US Patent 6,674,731) in view of *Birdwell* (US Application 2001/0024435).

Claims 25, 28 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bradshaw* (US Patent 6,674,731) in view of *Dillon* (US Patent 6,338,131).

Claims 26 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bradshaw* (US Patent 6,674,731) in view of *Dillon* (US Patent 6,338,131) and further in view of *Gernert* (US Patent 6,600,734). Applicant respectfully traverses the rejections. Favorable reconsideration is respectfully requested.

Specifically, none of the cited references, alone or in combination, disclose interfacing the terminal with the host to support transmission of data bursts from the terminal to the host, the data bursts conforming with a bus standard of the host as recited in amended claim 1 and similarly recited in claims 9, 17 and 25.

Regarding *Bradshaw*, the Office Action concedes that these features are not disclosed in the document. As a result, the Office Action relied on *Gernert* (col. 10, lines 44-52) to allegedly solve the deficiencies of *Bradshaw*. Applicants submit such a combination is improper as there is no teaching, suggestion or motivation to combine *Gernert* with *Bradshaw* in the manner suggested in the Office Action. While *Bradshaw* discloses a system for communicating TCP/IP data over a satellite communication channel (col. 3, lines 32-55), *Gernert* discloses a system for interfacing a wireless LAN with a wired voice telecommunications system (col. 1, lines 21-26). *Gernert* teaches that apparatus 50 (i.e. bridge) combines the functions of a wireless communication system access point and a telephony gateway in a single unit, where the mobile

unit 15 is utilized as a voice communication handset, wireless portable telephone, or data entry unit (col. 7, line 59 – col. 8, line 7). Apparatus 50 connects to a VoIP gateway 62, analog modem gateway 64 or other gateway 66, via a multiplexor/demultiplexor 60 (FIG. 3). The gateways provide different modes of radio communication between the mobile unit and the gateway. *Gernert* further discloses that, in addition to the gateways, apparatus 50 may contain other data ports 96, such as IEEE 802.X or USB to allow the gateways to connect to other nodes on a wired LAN to transfer data. In other words, *Gernert* merely teaches the use of serial interfaces to allow gateways to communicate over conventional data connections.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would

be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

In the present case, the Office Action alleged that the combination was suggested by the need for interoperability between the “receipt and use of regular and bursty transmissions that contribute to improved performance characteristics.” However the present claims also require the terminal to be interfaces with the satellite to permit exchange of the data frame, the data frame conforming with different return channel frame formats, as well an interface to the hub to support the exchange of data from the hub to the terminal using a multi-layer protocol. When taken in combination, there is no teaching, suggestion or motivation to combine *Bradshaw* and *Gernert*, as *Bradshaw* does not address conforming bursts to a bus standard of a host, and *Gernert* merely describes alternate modes of communication via standard communication links.

In light of the above, Applicant respectfully submits that claims 1, 3-9, 11-17, 19-25 and 27-32 of the present application are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. §102 and §103 be withdrawn and a timely Notice of Allowance be issued in this case. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (115426-531) on the account statement.

Respectfully submitted,

HUGHES NETWORK SYSTEMS

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